UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/502,053 | 07/30/2004 | Jun Fujimoto | 256785US2XPCT | 2145 |

22850 7590 07/25/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| MOSSER, ROBERT E | |
| **ART UNIT** | **PAPER NUMBER** |
| 3714 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/25/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/502,053 | FUJIMOTO ET AL. | |
| | Examiner | Art Unit | |
| | Robert Mosser | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5,8-10,12,14-23,26-28,30 and 32-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,8-10,12,14-23,26-28,30 and 32-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim **18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function (MPEP 2105). In the present case the specification fails to set forth the equivalent structures or materials corresponding to the claimed means and accordingly fails to enable the invention. One of ordinary skill in the art would not readily recognize what components or devices would perform the functions associated with the disclosed means and accordingly implementation of the instant inventions would require undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim **18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

In the present case the applicant has failed to correlate the claimed means to any equivalent structure and in such failed provide a basis for the determination of equivalency within the claims. One of ordinary skill in the art would not be apprised of the metes and bounds of the claimed invention in absence of this correlation as they are presently not provided with any disclosure to form a basis for such a determination.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-5, 8-10, 12, 14-23, 26-28, 30,** and **32-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US 5,411,258) in further view of Walker et al (US 6,001,016).

Claims **1-5, 8, 12, 14-15, 19-23, 26, 30,** and **32-35:** Wilson teaches a multiple player (mass) competitive racing game device executing software programs to provide:

a time management unit configured to advance an entry time in which a plurality of users/players can enter the game (*Wilson* Col 6:60-68 & 8:36-39);

a decision unit configured to determine the game result through the finish order of the race horses before the entry time managed by the time management unit elapses through selecting a prerecorded race with a known result prior to the placement of a player wager (*Wilson* Col 1:45-58);

a forecast information obtaining unit adapted to capture respective user/player forecasts of the game outcome prior the elapse of the entry time (*Wilson Col 8:36-39*);

a determination unit configured to determine whether the game result and the respective player selection match prior to the elapse of the entry time (*Wilson* Col 7:45-52);

an advancement/ effect decision means unit for advancing the display of the racing game effect contents and length of said effect contents according to the to the determined game result after the closure of a entry time and with the passing of a start time (*Wilson* Col 4:13-27);

a calculation unit configured to calculate a user/player payout amount based on a match between the game result and the player selection prior to the elapse of the entry time (*Wilson* Col 8:44-9:19);

Wilson however is silent regarding the inclusion of,

a game controller adapted to control a game execution between a game controller and a terminal reflective instructions received from the terminal.

In a related wagering device Walker teaches the inclusion of a remote terminal server system to provide a game controller adapted to control a game execution between a game controller and a terminal reflective instructions received from the terminal (*Walker* Figure 3 & Elm 4, 10). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporate the server terminal structure as taught by Walker into the invention of Wilson order to enable group player between a plurality of player across geographically disperse locations.

Claims **9-10,** and **27-28**: Wilson further teaches the ability of the game device to alter the effect contents of the game based on the number of players operating a common instance of the game through altering the game layout and payout determination (Wilson Col 8:54-19).

Claims **16-17**: Wilson teaches the features of a notification unit for notifying the user terminal of the game results through the presentation of the race to the player after the start time.

Claims **18** and **36**: Wilson teaches player identification however is arguably silent regarding the inclusion of player authentication. The invention of Walker however teaches the incorporation of player authentication (*Walker* Col 8:49-9:7). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the authentication features Walker into the invention of Wilson in order to prohibit unauthorized use of the gaming device

### *Response to Arguments*

Applicant's arguments with respect to claims **1-5, 8-10, 12, 14-23, 26-28, 30,** and **32-36** have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/
July 16th, 2007

MARK SAGER
PRIMARY EXAMINER